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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,325	12/04/2001	Michael S.H. Chu	-06530.0285-00000.	9761

7590 01/31/2005

Leslie I. Bookoff, Esq.  
Finnegan, Henderson, Farabow,  
Garrett & Dunner, L.L.P.  
1300 I Street, N.W.  
Washington, DC 20005-3315

EXAMINER
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THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/000,325	<b>Applicant(s)</b> CHU, MICHAEL S.H.	
	<b>Examiner</b> Michael Thaler	<b>Art Unit</b> 3731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 and 61-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 and 61-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Claims 1-4, 8-10, 14-19, 22-26, 31-34, 38, 39, 61-64, 68-70, 74-79, 82, 85-90, 95-98 and 102-104 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mitsuru (Japan JP6343599). Mitsuru, in figures 5, 6A and 6B, discloses elongate member (either 10 or 20) for insertion into a channel of the endoscope 50, distal assembly 70 having an open configuration (figure 6B) and a closed configuration (figure 6A) with a profile larger than a diameter of the channel of the endoscope 50 (noting that the profile of distal assembly 70 has a diameter which is larger than the diameter of the channel of the endoscope 50 as seen in figure 6A). As to the language "configured to be loaded into a channel of an endoscope" in claim 1, lines 1-2, which require the endoscopic device to be capable of existing outside of the channel of an endoscope, it is unclear if the Mitsuru endoscopic device, once assembled with the endoscope during manufacture, is detachable from the endoscope. However, assuming arguendo that it is not detachable, the endoscopic device, in the state prior to its' assembly into the endoscope during manufacture meets the terms of the claims. Alternatively, it would have been obvious that it is configured to be loaded into a channel of an endoscope for this reason. As to claim 3, Mitsuru discloses a member near the proximal end of

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the elongate member at the handle (at arrow 60) which inherently acts as a stop. As to claim 8, activation shaft (e.g. 20) is inherently capable of rotating the distal assembly when the activation shaft is rotated. As to claim 9, the distal end of the activation shaft is bent when it is in a curved path in the body. As to claim 10, the distal assembly is inherently capable of obtaining and storing multiple small samples. As to claim 15, Mitusuru discloses ring 22. As to claim 19, Mitusuru discloses ring 22 and tube (the tube just inside tube 50). As to claim 26, Mitusuru discloses extension (the proximal portion of 10 extending proximally from 50 as seen in figure 5). As to claim 61, the Mitusuru distal assembly includes a tube (the tube just inside tube 50) and an end effector 70 having a profile (at the proximal portion of the end effector 70 which attached to ring 22) in the closed configuration that is smaller than a profile of a lumen of the tube, as broadly claimed. Note that the profile of this portion of end effector 70 is smaller than the profile of the distal end of the end effector 70. As to claim 82, the outer surface of the proximal end of the tube abuts the inner surface of the distal end of the endoscope 50.

Claims 5-7, 11-13, 27-30, 35-37, 65-67, 71-73, 91-94 and 99-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuru (Japan JP6343599) in view of Townsend et al.

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(6,066,102). As to claims 5, 6, 27-29, 65-67 and 91-94 Mitsuru fails to disclose the details of the handle with the slide. However, it is old and well known in this art to so construct handles for reliably and smoothly activating surgical end effectors. For example, Townsend et al. discloses casing (the frame on which handle 42 slides), slide 46, cap (at the proximal end of the frame), knob 44, 42 and a groove (the groove that 44 slides in). It would have been obvious to so construct the Mitsuru handle at 60 so that it too would have this advantage. As to claims 7, 11-13, 30, 35-37 and 71-73 Mitsuru fails to disclose the details of the elongate member. However, it is old and well known in this art to so construct elongate members for reliably and smoothly activating surgical end effectors. For example, Townsend et al. discloses needle 718 and a lumen 28 to receive a medical device (col. 6, lines 44-55). It would have been obvious to so construct the Mitsuru elongate member so that it too would have this advantage.

Claims 20, 21, 80, 81, 83, 84 and 105-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuru (Japan JP6343599) in view of Lichtman (5,218,589). Mitsuru fails to disclose a spring housed within the tube. However, Lichtman teaches that a spring (either of the spring leaves 62, 64) should be used to bias forceps jaws open which has the apparent

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advantage of insuring that the jaws open when desired. It would have been obvious to include spring leaves in the Mitsuru device so that it too would have this advantage.

Applicant's arguments filed Nov. 1, 2004 have been fully considered but they are not persuasive. Light guide part 50 of Mitsuru is considered to be part of the endoscope since it transmits light. However, assuming arguendo that light guide part 50 of Mitsuru is not considered to be part of the endoscope, then the main part of the endoscope (i.e. the part other than light guide 50) is considered to be the claimed "endoscope". Distal assembly 70 has a profile which is larger than the channel of the endoscope (the main part of the endoscope) as claimed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht  
1/25/05



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731